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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,593	08/05/2003	Jerrold V. Hauck	APPL-P2834DVF	1380

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EXAMINER	
JUNG, MIN	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/635,593	HAUCK ET AL.	
	Examiner	Art Unit	
	Min Jung	2663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,3,5,6 and 8-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *8,19 and 20* is/are allowed.

6)☒ Claim(s) *2,3,5,6,9-18 and 21-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10, 11, and 13-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to describe the limitation of claims 10, 11, 13, and 14 that the "legacy request symbol comprises a priority".

The specification also fails teach the "first serialized protocol" and the "second serialized protocol", as recited in claims 15 and 25, and the "method for issuing a inactivity-related communication------" recited in claim 15.

Claim 15 further recites "timing a period of idle bus activity in at least a portion of said hybrid bus operating according to said serialized protocol" – no such teaching is found in the specification. Claim 15 further recites, "generating an inactivity-related communication corresponding to said period of idle bus activity" – no such teaching is found in the specification. Claim 15 further recites, "transferring said gap-related communication to said one node" – no such teaching is found in the specification.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 3, 9-14, 21-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 2, 3, 25, and 30, "said data structure adapted to be stored in a computer memory" is unclear in that the phrase "adapted to" make the storage optional, and therefore, the metes and bounds of the claim is not defined.

Regarding claims 12-14, there is inconsistency in referring to their base claims - "the machine readable medium" for the previous recitation of "machine readable data transmission".

Regarding claim 21, lines 6, 8, and 9, "said device" is unclear since a clear antecedent basis is lacking; should it be "one of said at least one device"?

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2, 3, 9-14, 25-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 2 and 9-11, "a machine readable medium" claimed seems to include not only the computer readable storage medium, but also transmission mediums from interpreting the description at page 14, paragraphs [0056] and [0057]. To make the claim statutory, it is recommended to recite the preamble as "a computer readable storage medium-----", and change "data structure" to "a computer program", "software", or "computer executable instructions" since data structure can mean a frame structure or a data table, etc.

Further regarding claim 3 and 12-14,"a machine readable data transmission" is clearly directed to a signal transmission itself and not to a tangible computer readable storage medium as required by the eligible patent subject matter.

Claims 25-34 contain similar problems as the ones addressed above for claims 2, 3, and 9-14.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 5 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Stone et al., US 6,519,657 (Stone).

Regarding claims 5 and 6, Stone teaches a full-duplex communication system comprising a plurality of border nodes within a beta cloud, a method for issuing gap tokens within a beta cloud comprising: selecting one border device among the plurality of border devices to be a BOSS node (col. 5, lines 20-25, col. 9, lines 1-5, and lines 50-62); detecting a period of idle bus activity (col. 9, lines 1-5, and lines 52-54); and having the BOSS node generate a gap token upon the detection of the period of idle bus activity (Applicant has defined the "gap token" as "the BOSS equivalent to a Legacy gap event". Stone teaches legacy gap event throughout the specification, and gap timers are included in border nodes as well as any other nodes). Further, "senior border node" reads on a border node currently acting as a boss.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 2, 3, and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone et al., US 6,519,657 (Stone).

Stone discloses a method and device for identifying an active 1394a node attached to a 1394b network.

Regarding claims 2, 3, and 9-14, Stone teaches indicating that a device from a legacy cloud wishes to arbitrate within a beta cloud (col. 6, lines 12-13, and col. 9, lines 2-67). Stone fails to specifically teach that the border node generates a symbol comprising the indication. The generation of the symbol as taught in the present specification is not a generation but actually a conversion/modification of the arbitration request into a "Legacy request" to indicate to the B PHYs (1394b node) of the request from a legacy node. Stone teaches a conversion/modification of a self ID packet by setting a reserved bit to one to indicate to 1394b nodes that a legacy node (1394a node) is present. Therefore, Stone teaches the concept of packet modification at the border node to indicate the presence of a legacy node to the B nodes. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to apply the data modification by the border node taught for the indication of the presence of 1394a node to modify the arbitration request at the border node to indicate to the beta cloud that the request is from the legacy cloud.

Allowable Subject Matter

10. Claims 8, 19, and 20 are allowed.

Response to Arguments

11. Applicant's arguments with respect to claims 2 and 3 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's arguments filed September 28, 2006 have been fully considered but they are not persuasive.

Regarding applicant's argument concerning the rejection based on 35 USC 101, applicant's attention is directed to the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility signed by John J. Doll, October 26, 2005.

Regarding claims 5 and 6, applicant explains the difference between the claims and the teaching of Stone. However, claims as recited do not clearly distinguish from the teaching of Stone. The full explanation is given above in the rejection. Applicant enunciates that Stone does not disclose gap tokens, as such are unnecessary since all of Stone's 1394b devices have gap timer logic built in. However, the claims as recited do not require such reasoning to be properly rejected. Since applicant has equated gap token to a Legacy gap event, the legacy gap event taught by Stone meets the claim limitation.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Jung whose telephone number is 571-272-3127. The examiner can normally be reached on Monday through Friday 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 571-272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJ
December 7, 2006

Min Jung
Primary Examiner